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**In the Supreme Court of the United States**

**OCTOBER TERM, 1945.**

**No. 137.**

THE TIMKEN-DETROIT AXLE COMPANY,  
*Petitioner,*

vs.

CLEVELAND STEEL PRODUCTS CORPORATION,  
*Respondent.*

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**REPLY BRIEF OF PETITIONER ON PETITION  
FOR WRIT OF CERTIORARI AND REQUEST FOR  
LEAVE TO FILE AND FOR CONSIDERATION OF  
THE SAME.**

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NOW COMES the Petitioner and asks leave to file the attached Reply Brief and for consideration thereof.

**That Confusion and Conflict** between and among the Courts of Appeals, the District Courts and Judges in the same District below on the issues here involved were disclosed and established by the decisions and excerpts cited therefrom at pages 5 to 7, 10 to 11, and elsewhere in our Main Brief, is not, and cannot be, denied;\* both are manifest on the face of each of these and numerous other decisions. Such conflict and confusion between and among the Courts and Judges below has always been regarded

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\* The statements we have made at these pages and on pages 12 to 14, and the curves opposite page 13, are based on such records as the Federal Reporter, the Federal Reporter Digests and Indices, the Reports of the Commissioner of Patents, the Census Reports, and other public records and documents, and on recent history, of which the Courts take judicial notice (*Walling v. Patton*, 134 Fed. (2) 945 (CCA 6); *Heath v. Wallace*, 138 U. S. 573, 584; *Arizona v. California*, 283 U. S. 423, 454).

by this Court as reason for granting certiorari and certiorari has been almost universally granted on more limited and less important conflicts (*Fisher v. Whiton*, 317 U. S. 217, 219; *Lilly v. Grand Trunk*, 317 U. S. 481, 483; *Miles v. Illinois*, 315 U. S. 698, 700; *Davis v. Department of Labor*, 317 U. S. 249, 254).

**Certiorari Granted Where There is Conflict on the Interpretation of a Statute:** The granting of certiorari is by no means limited to causes of conflict of decisions on specific questions such as the diversity of decisions on the question of whether the standard of invention has been changed, but is often granted where there is conflict on the interpretation of a statute, as is true of the patent statutes bottomed on the "invention" recited in such statutes (see for example, U. S. R. S. Sec. 4886). Indeed, all the patent statutes root back to "invention" and depend upon its interpretation. For example, in *Fisher v. Whiton*, 317 U. S. 217 this Court granted certiorari where there was such conflict, saying through Mr. Justice Murphy (p. 219):

"The Chancery Court held that petitioner's assessment claim accrued on the date first fixed for payment, May 23, 1934, and that the claim was barred by Sec. 8225 of the Tennessee Code fixing a period of 'six months from the date the cause of action thereon accrued' within which to enforce previously unmatured claims against decedents. The Court of Appeals affirmed, relying upon Sec. 8604 of the Code as well as Sec. 8225. 25 Tenn App 230, 155 SW (2d) 882. The Supreme Court of the State denied a petition for writ of certiorari. The importance of the question in the administration of insolvent national banks and a conflict with the decision in *Strasburger v. Schram*, 68 App DC 87, 93 F. (2d) 246, caused us to grant certiorari."

**Certiorari Granted Where There is Baffling Confusion Among the Courts Below:** The Court also grants certiorari where there is such "*confusion*" in the Courts below that counsel are unable to predict on which "side of the line" Courts or Judges will decide such questions as what constitutes invention and what not. Thus this Court in *Davis v. Department of Labor*, *supra*, speaking through Mr. Justice Black, said (p. 253):

"The very closeness of the cases cited above and others raising related points of interpretation has caused much serious *confusion*.

\* \* \* \* \*

(p. 255):

"In the face of the cases referred to above, *the most competent counsel may be unable to predict* on which side of the line particular employment will fall."

It would be difficult to conceive of a situation fitting so well the pattern here described as that depicted in the multiple attitudes and interpretations in the various Circuits which we have proved exists currently (see pp. 4 *et seq.* of our Main Brief). What lawyer, patent or other kind, can predict which of the three several views adopted in the decisions cited at page 7 of our Main Brief will be adopted by any Court in the future?

The intensity of this confusion, if not its lugubriousness, is manifested by the directly conflicting views expressed in the following two opinions by two District Judges sitting in Cleveland, Ohio. The only difference is that one sits in the Court Room on the east side of the Court House and the other sits in the Court Room on the west side of the Court House.

In his opinion in the case of *Merco Nordstrom v. Acker* (unreported), No. 5771, Judge Jones, who sits in the Court Room on the western side of the Court House in Cleveland, Ohio, in holding validity of two patents said, as follows:



"Of course, the rule that the patent grant furnishes a strong evidential presumption of validity and places a heavy burden upon the challenger to overthrow it still seems to me to be safe, just, and reasonable in patent infringement suits.

\* \* \* \* \*

"In this case there has been quite a lot of time devoted to the earlier art. It is quite clear that people for countless years have been endeavoring to find means or construction for preventing leakage in flow lines and also for preventing sticking of valves, and particularly when an emergency is presented, as was described in the case out west where an earthquake occurred."

(CCA opinion reported at 131 Fed. (2) 277.)

Judge Wilkin, who sits in the Court Room on the eastern side of the Court House, differs from these views, as is not only manifested by his decision in the instant cause, but in the more recent decision by him in *General Metals v. Wellman*, 57 F. S. 221 where, in rejecting the objective test and the presumption of validity based upon the grant of the Patent Office where no new art is presented, said in finding lack of invention (p. 223):

"This the conscientious judge regrets. Instinctively he prefers the exercise of objective to subjective judgment. Naturally the court is prompted by a desire to see every man rewarded for whatever contribution he has made to art or industry."

These regrets were made after citing from an opinion in the Second Circuit which holds to the view that there has been a change in the standards of invention contrary to the views in other Courts. The statement by Judge Wilkin is followed by a comment that the fundamental law must be changed in order to follow the practice followed by Judge Jones over on the other side of the Court House and by many of the Courts as shown at pages 4 and 5 of our Main Brief.

Ordinarily the confusion which baffles the prediction of competent counsel is found among Courts in different jurisdictions. Here, however, we have this confusion in the same Court House. How, for example, can counsel, competent or otherwise, predict whether his patent suit will go to the Court Room in the eastern side of the Court House at Cleveland, Ohio, or the western side? How can he advise his client, or even how can he prepare his case?

In Cleveland counsel, clients and witnesses go to the Court House on call for trial; counsel do not know until the threshold of the Court Room is reached which of these Judges will try the cause. How, then, could there be a clearer case of such confusion that counsel are "unable to predict on which side of the line" the cause will be determined, to quote Mr. Justice Black? How can counsel advise clients when counsel do not know in advance "on which side of the line" the cause will be tried? Certainly if confusion in different jurisdictions which baffle counsel is justification for granting certiorari, as was done in the cited case, then confusion even more baffling in the same Court House in the same District should justify the granting of certiorari. Indeed at the very time that the instant cause was on trial in the Eastern Court Room where the following rule was ignored, the Court in the Western Court Room handed down an opinion (unpublished) saying:

"There is, in my opinion, a heavy burden placed on the one in controversies of this character, who attacks the validity of a patent. I am inclined to adhere to the old rule that the evidential value of a patent is of sufficient importance to require pretty clear and convincing proof to overthrow that presumption." (*Whyte vs. Whyte Fly Tackle*, No. 20918.)

Certiorari is also granted "in cases of peculiar gravity and general importance or in order to secure uniformity of decision" (*Hamilton v. Wolf*, 240 U. S. 251, 258). **Here we have diversity and conflict of decisions (1) in the various**

**Circuits (2) in the various Districts and (3) between different judges in different Districts.**

**Remedies for This Confusion and Conflict:** Respondent says we suggest no remedies. If we had suggested none we think this Court would be persuaded to consider these conflicts and confusions to seek remedies, but we did suggest two remedies which have been proposed by others and followed by some of the Courts below, but not by others. In this respect our position is that of any petitioner for certiorari to settle disputes below. We ask the Court here to adopt the positions adopted and followed by one of the groups of Courts below.

The remedies and positions of certain courts below which we have suggested this Court adopt are as follows:

(1) Resort to the objective test plan suggested by Mr. Roosevelt's Patent Planning Commission\* and employed by some of the lower Courts in many decisions;\*\* and

(2) Giving the same weight to the Findings and Conclusions of the Patent Office Examiners as is ordinarily given to the Findings and Conclusions of other Boards and Tribunals created by the Government, especially since the Patent Office Tribunals are skilled in the sciences to which the inventions relate and, notwithstanding Petitioner's contention to the contrary, as skilled in the patent law as these other Tribunals are skilled in the law to which their

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\* On the subject of the objective test the Commission said at page 10 of its Report:

"The Commission therefore recommends the enactment of a declaration of policy that patentability shall be determined objectively by the nature of the contribution to the advancement of the art, and not subjectively by the nature of the process by which the invention may have been accomplished."

\*\* *Wahl v. Andis*, 66 Fed. (2) 164 (CCA 7); *Chicago v. Burnside*, 132 Fed. (2) 812 (CCA 7); *Sbicca v. Milnis*, 145 Fed. (2) 389 (CCA 8).

subject-matter relates, and as skilled in the law as the Courts who sit in patent causes. Some of the Courts follow this rule (*Adler v. Wagner*, 112 Fed. (2) 264, 267 (CCA 7); *Fairbanks-Morse v. Stickney*, 123 Fed. 79, 82 (CCA 8); *Simplex v. Thacher*, 38 Fed. (2) 826, 828; *Detroit v. Burke*, 4 Fed. (2) 118, 122; *Copeman vs. General Plastics*, 140 Fed. (2) 962, 964 (CCA 7).

We recognize a reason for a different view where, and if, new and important art is offered in Court which was not before the Patent Office, but such is not true in the instant cause where the art selected by the defendant's expert as the best art before the Courts was also before the Patent Office, and where it was carefully considered by the Patent Office (Vol. II, pp. 603-606). Indeed, as we pointed out, all of the art before the Courts, except a few immaterial "rag-tags and bob-tails," was before the Patent Office. The only answer the Petitioner can make to this is to point to the conflicting expert testimony offered to the Court and whose sole design was to endeavor to furnish the Court with the technical knowledge already possessed by the Patent Office Examiners as a result of their education and training in the pertinent sciences. Often the Courts have pronounced that this conflicting expert testimony submitted to aid the lay Judge is more confusing than helpful and at least one of the District Judges below (Judge Coleman in the District of Maryland) has frequently resorted to the practice of appointing a neutral expert to relieve him from the helplessness caused by such conflicting expert testimony.

It makes no difference in the inter partes proceedings before the Patent Office that Respondent was not a party because here we are dealing with the question of comity and not with the question of estoppel by judgment.

Therefore, our proposition is not that all patents should be sustained, as Respondent contends; we have proven and do contend that in the bedlam that now exists

so few have been sustained that the disastrous results depicted in the curves opposite page 13 of our Main Brief, and explained in the pages adjacent thereto, has resulted.

**Answer to the Alleged "Concurring Findings of the Lower Courts":**

(a) The questions which we present here are questions of law.

(b) There is no evidence at all to support a finding of non-invention.

(c) There is no substantial evidence to support a finding of insufficiency of disclosure.

(d) There is diversity of decision between the Patent Office Tribunals and the Courts below.

(a) (1) Whether or not invention is present where the patentees have made a great contribution, solved a problem, succeeded where many others had failed, etc. (in other words, where the objective tests are present) is a question of law once the Court below has found the presence of these facts, as the District Court found and recited in his Opinion and Findings (see pp. 2-3 of our Main Brief).

(a) (2) Assuming that there had been no more than a change in materials, as Respondent contends, the question of whether or not there is invention in a change of materials is a question of law.\* Once the Court has found

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\* In *Ray-O-Vac v. Goodyear*, 45 F. S. 927 (affirmed by this Court 321 U. S. 275), the District Court said (p. 931):

"Even substitution of metals may constitute invention where it produces a new function and the first practical success in a needed device, in which the substitution makes for increased efficiency. *Edison Electric Light Co. v. United States Electric Lighting Co.*, 2 Cir., 52 F. 300, 308."

See also *United Shoe v. Ferree*, 64 Fed. (2) 101; *Dewey v. Mimer*, 124 Fed. (2) 986; *Akme v. Aluminite*, 27 Fed. (2) 736 (C. C. A. 2); *Samson v. Sears*, 103 Fed. (2) 312 (C. C. A. 2); *Smith v. Goodyear*, 93 U. S. 486; *Potts v. Creager*, 155 U. S. 597, 608; *G. E. v. Hoskins*, 224 Fed. 464 (C. C. A. 7).

the facts to be that important results have been achieved, as the District Court found in the instant cause.

(a) (3) Whether or not there is invention in a new combination of old elements involving all of the changes possible in a machine is also a question of law\* once the Court had made the fact findings that the elements of the new structure differ from the prior art in size, shape, dimensions, materials, and the relations of the parts to each other, as the District Court found below.

(a) (4) Whether or not a disclosure is sufficient to teach those skilled in the art is a question of law for the Court, and one whose determination by lawyers skilled in the art is, in our view, more to be relied upon than those not skilled in the art (*Singer vs. Cramer*, 192 U. S. 265; *Sanitary vs. Winters*, 280 U. S. 30, 50; *Solomon vs. Renstrom*, 57 F. S. 223).

(b) All of the Findings of Fact of the Courts below establish the presence of invention. These include the Lower Court's Findings of the presence of the objective tests and all the differences in structure by which machines are capable of differing from each other. Not only is there no evidence to support a contrary finding on any of these subjects, but the Court made no findings thereon to the contrary. There is, therefore, no evidence to support a conclusion that there is no invention.

(c) The only evidence to support a claim of insufficiency of disclosure is a rather furtive comment on this subject by the defendant's professional expert who by his own attempts at qualification showed that he knew less about this art than the Examiners in the Patent Office, those who prepared the patent specifications, those who reviewed them, or those who testified they were sufficient. In addition, of course, there is the partisanship of de-

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\* See decisions cited in the footnotes at pages 24 and 25 of our Main Brief.

fendant's professional patent expert.\* There is, therefore, no substantial evidence to support the claim that the disclosures are insufficient.

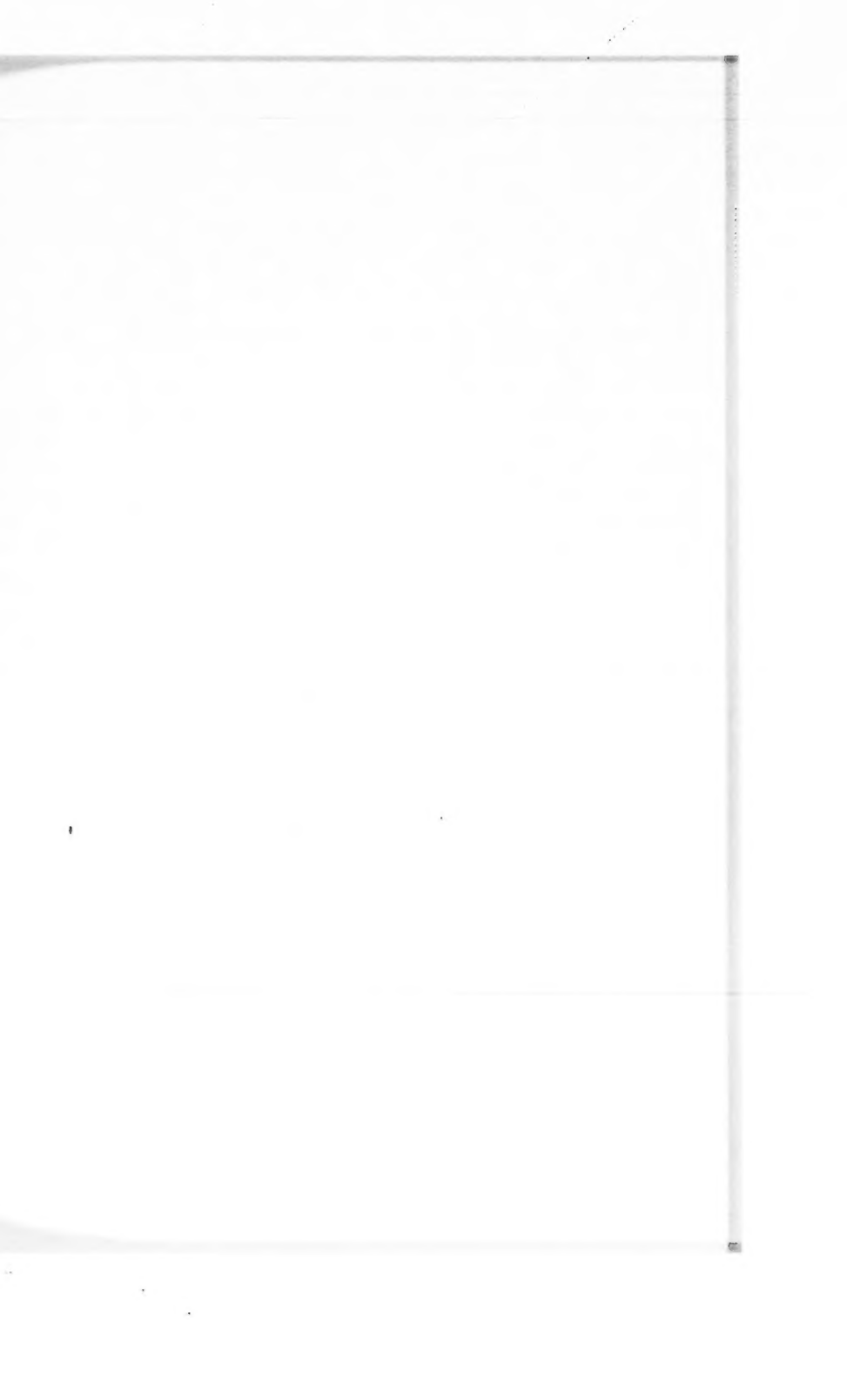
(d) Since in this cause the art on the question of invention and mechanical skill before the Courts was the same as before the Patent Office and the disclosures in the patents before the two Tribunals were the same, there was diversity of decision between the Patent Office Tribunals and the lower Courts. As we have already pointed out, determination of both of these questions is, and must be, bottomed in knowledge of the science and mechanics involved in which the Patent Office Tribunals are more skilled, as cannot be disputed here.

**Carbon Monoxide Flame:** Under well established authority the failure to mention this particular feature in the patent in suit is immaterial (*Eames v. Andrews*, 122 U. S. 40, 56).\*\* The failure to mention this carbon monoxide flame, known to every chemist and combustion engineer to be present in the practice of the patented furnaces, as exhibited by the blue flame (see Fig. 4 hereof), while immaterial in law, illustrates the confusion and error which results from relying upon the views of laymen in science who are unfamiliar with this feature instead of relying upon the views of those skilled in the art who are familiar with it, such as the Patent Office Examiners. It also serves to show that the Patent Office Examiners are skilled in the

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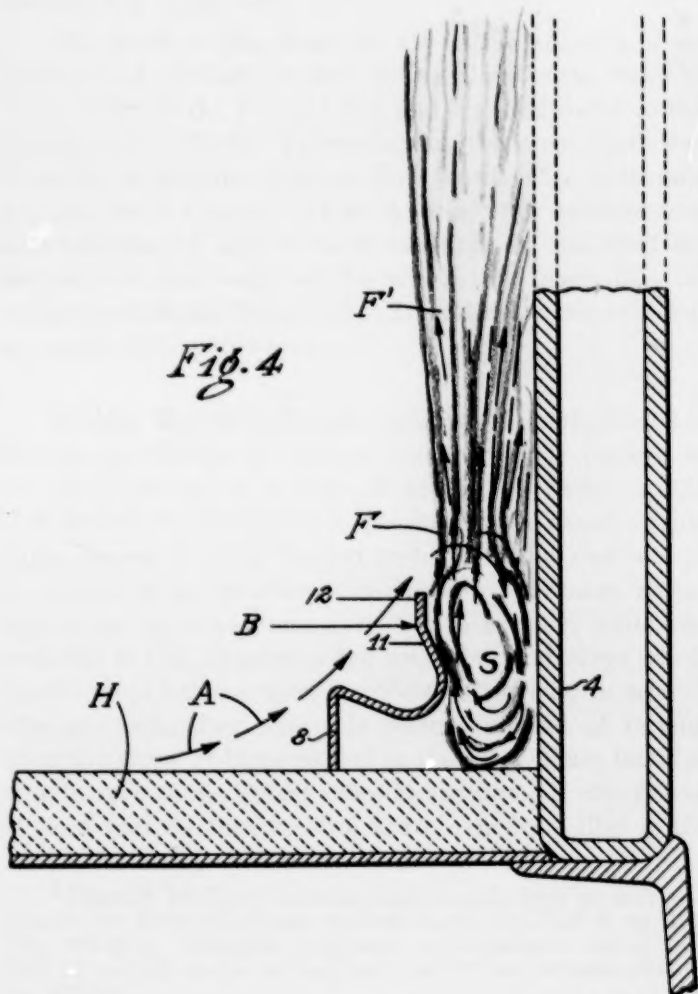
\* Plaintiff produced practical experts each with no skill as a witness, but fully skilled and qualified in the art (Vol. I, pp. 131-132; 205-207); defendant produced a professional expert with little or no skill in the art and fully skilled as a witness (Vol. I, pp. 523-524).

\*\* "An inventor may be ignorant of the scientific principle, or he may think he knows it and yet be uncertain, or he may be confident as to what it is, and others may think differently. All this is immaterial, if by the specification the thing to be done is so set forth that it can be reproduced." (122 U. S. 56.)





*Fig. 4*



rules of patent law such as those pronounced by this Court in *Eames v. Andrews*, *supra*.

No patent specification could be so complete as to instruct the layman in all of the scientific features and principles involved in such furnaces as covered by the patents in suit. The draftsman of the specification is, therefore, forced to proceed on the premise that his description is addressed to those skilled in the art and, in the instant cause, familiar with such things as the carbon monoxide flame and its presence in such furnaces; such is all the law requires.

There are many other gases and other features than the carbon monoxide inherent in the combustion of oil, all familiar to those skilled in the art (Vol. I, pp. 158-159).

To include all this known phenomena and all these operations in a patent specification would make it endless and then infringers would ask for holdings of invalidity on the grounds of prolixity.

At page 23 of our Main Brief we indicated that this operation and feature was illustrated in Fig. 4 which was to have been included in that brief but which, through an oversight, was omitted. We include it, with our apologies, opposite the present page.

**The Inventors and Not the Plaintiff Made the "Contributions":** In his opinion Judge Wilkin sometimes referred to the inventors as the plaintiff. This undoubtedly was because the patents in suit are assigned to the plaintiff. The contribution made, of course, was made by the inventors who made the inventions and developed the preferred embodiments disclosed in the patents in suit. The plaintiff did not make the contributions. All the evidence in the record is to the effect that the inventors made the contributions and not the plaintiff. Therefore, when Judge Wilkin said that the "great contribution" to the solution

of the problem was made by the plaintiff he was talking about the inventors. This is clear from the context.

**"Making Some Adjustments of Parts,"** a phrase used, with other similar phrases, by the District Judge in connection with the change of materials, is indefinite as it stands. Its indefiniteness, and that of other such statements, is cleared up when construed in connection with the Judge's statement of what constituted "some adjustments of parts," or the like. This is found in the following language (Vol. II, p. 1065)

"True, as plaintiff says, 'there has been a change in the shape and in the size and dimensions \* \* \* and differences in the relation to each other of the parts,'."

**Taking Features From Multiple Prior Art Devices:** Notwithstanding Respondent's sharp denial, this is what the Courts below did as Judge Wilkin said in his Findings of Facts, as follows (Vol. II, p. 1067):

"8. Some of the features of the claimed inventions are disclosed in the Heath patent, some in the Bird patent, some in the Kolva patent, some in the Braun patent, some in Exhibit DXM, and some in Exhibit DXN, and were to the extent of such disclosure anticipated by such patents."

Even when these features are selected here and there from these numerous prior art entities, there is not full anticipation, but only "*to the extent of such disclosures,*" to use the Court's words. In other words, even when the prior art is ransacked for features, and such features are picked up here and there, there still is no complete anticipation.

**Conclusion:** The outstanding issues raised in our Petition and Brief thereon are not disputed, as we read Respondent's Brief. These issues are that great confusion

and conflict exists in and among the Courts and other patent Tribunals below on the questions of the standard of invention\* and sufficiency of disclosure; both questions are involved in the instant cause with the conflict on each subject between the Examiners in the Patent Office, who are skilled in the sciences, and the Courts below, who are not; these questions are inherently questions involving science and the patent law in which the Patent Office Examiners are also skilled, and that this confusion and conflict is so great currently that nobody knows what patent will be held to disclose invention and be sufficient and what not, with the disastrous results of a rapid decline in invention, patent applications, and patents in this country. The importance of settling these issues, and that they can be settled in the instant cause, is manifest even if all Respondent contends were correct.

Respectfully submitted,

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\* The contentions on this subject range all the way from the "flash of genius" theory to the standard of "98% perspiration and 2% inspiration" attributed to Mr. Thomas A. Edison.